

REMARKS

Applicant appreciates the time taken by the Examiner to review Applicant's present application. Applicant has amended Claims 1, 12, 23 and 24, cancelled Claim 25 and added Claims 26-32. Applicant respectfully submits that no new matter has been added. Accordingly, Claims 1-24 and 26-32 remain pending in this application. This application has been carefully reviewed in light of the Official Action mailed April 11, 2006. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 1-4, 8-15, 19-23 and 24-25 stand rejected as anticipated by U.S. Patent No. 6,859,909 ("Lerner"). Applicant has cancelled Claim 25, and respectfully submits that the rejection of this claim is now moot. With respect to Claims 1-4, 8-15, 19-23 and 24, however, Applicant respectfully traverses this rejection.

Overview of Embodiments of the Invention

Embodiments of the invention allow metadata elements and target elements of a target document to be displayed in the same rendered document displayed by a browser. In certain embodiments this may be accomplished by accessing a target document comprising target elements, a metadata document comprising metadata elements and a document comprising rendering instructions. The target document comprises code (e.g. HTML or other code) which may be rendered to produce a view or page to a user, the code comprising the set of target elements. The metadata document comprises the set of metadata elements, which apply or describe certain types of target elements. The set of rendering instructions describes how a particular type of metadata element should be turned into, or transformed into, a rendered element.

For each of the metadata elements in the metadata document it is determined whether a matching target element can be found in the target document. In certain embodiments, to make these determinations the code of the target document is parsed to obtain the target elements. If a matching target element is found for a metadata element, a rendering instruction

which applies to the metadata element is used to produce a rendered element from the metadata element.

This rendered element can then be displayed in conjunction with the target element. In one embodiment, this may be accomplished by inserting the rendered element into the rendered target document during rendering of the target document, or subsequently thereto. Thus, in embodiments of the invention, the rendered element and the target element are displayed in a single rendered document.

Lerner

The Lerner reference, in direct contrast, "overlays an active image file onto the WBD [web based document] to simulate drawing directly into the browser." (See, Lerner Summary of the Invention, Lines 45-48, Col. 8, Lines 41-44). More particularly, the annotation software of Lerner allows a user to annotate a rendered web page by inserting on top of that rendered web page a transparent image file that contains the annotations. To allow a user to interact with the rendered web page the annotation software may allow browser events to pass through the annotation image file so that a user has complete access to the underlying rendered web page. (See, Lerner, Col. 7, Lines 3-9)

To allow a user to create an annotated web page, the annotation software of Lerner creates an annotation record to capture information about a user's annotations and then overlays a blank image file on top of a rendered web page. Annotation software then waits for the user to add an annotation event. The technical annotation information is then appended to the annotation record by appending the annotation image to an image file. (See, Lerner Col. 8, Line 45-Col.9, Line 5) This image file is then overlaid on top of the rendered web page to create an annotated web page. (See, Lerner Col. 10, Lines 27-30) Thus, an annotation record contains pertinent information relating to the appearance or make-up of a single annotated web page by storing information related to the original (unannotated) web page and an image file containing the annotations. (See Lerner Col 4, Lines 65-Col. 5, Lines 9) Furthermore, this means that an annotation record does not contain information pertaining to individual annotations, but instead the annotation record contains an image file which contains all the annotations. (See, Lerner Col.7, Lines 3-8)

Since, when displaying an annotated web page, the image file created by the annotation software overlays the prior top most layer of the original unannotated web page it blocks input

device events. Thus, to allow input events to pass through to the original unannotated web page Lerner must “burn a hole” in the image file around an input device so that input events can find their way to the original unaltered web page below the image file. (See, Lerner Col. 10, Lines 37-48)

Claims 1, 12, 23 and 24

Claim 1, as amended, recites a method of modifying a target document comprising accessing a first file comprising code renderable to produce a target document, a second file comprising a metadata element, and a third file comprising a rendering instruction, wherein the code comprises a target element, locating the target element to which the metadata element applies by processing at least a portion of the code of the first file, transforming the metadata element into a rendered element by using the rendering instruction and displaying the rendered element in conjunction with the target element. Claims 12, 23 and 24 recite similar limitations.

First and foremost, Lerner does not disclose three files, where the first file comprises code renderable to produce a target document where in the code comprises a target element, the second file comprises the metadata element and the third file comprises transformation instructions as recited by Claim 1.

Part and parcel with the above assessment, Lerner also does not disclose processing at least a portion of the code of the first file (e.g. the code comprising the target elements and renderable to produce a target document) to locate a target element to which a metadata element as recited by Claim 1. As described by the Examiner himself, the way that Lerner locates a target element to which the metadata element applies is that the “annotation record maintains a pointer to the target element that an annotation modifies.” (See, Office Action, Page 3, Lines 5-6) Moreover, an annotation record stores the file location of the original unannotated web page. (See, Lerner Col. 7, Lines 23-26) Thus, the annotation record stores the file location of the unannotated web page, not elements within that unannotated web page which are comprised by code renderable to produce that unannotated web page. Thus, Lerner does not disclose processing at least a portion of code renderable to produce a target document to locate a target element, as recited by Claim 1.

Furthermore, as Lerner employs a single annotation record for an annotated web page, where the annotation record contains a reference to the unaltered web page and an active image file which contains all the actual graphical images comprising all the annotations, Lerner

does not disclose a metadata element (which may describe a type of target element), a rendering instruction (which may describe how a metadata element is supposed to be transformed or rendered into a rendered element) or transforming the metadata element according to the rendering instruction (See, Lerner Col. 5, Lines 1-9)

While the Examiner asserts that rendering instructions for the metadata elements are stored in the image file containing the appearance of the metadata, the Applicant respectfully disagrees. The image file contains the graphical image which correspond to all the annotations for an annotated web page. Thus, nothing in the image file describes how metadata, or anything else, is supposed to transformed or rendered. Instead the image file contains the actual image that will be overlaid on an unaltered web page in order to annotate that web page. (See, Lerner Col. 10, Lines 42-45) Additionally, the annotation record or annotation of Lerner is never transformed according to the image file to produce a rendered element

To elucidate more clearly, the Examiner states that the metadata element of Claim 1 is the annotation of Lerner which is stored in an annotation record (See, Office Action, Page 3, Line 1-3) while the rendering instruction of Claim 1 is the image file of Lerner which comprises the appearance of the annotations. (See Office Action, Page 3, Line 3, Lerner Col. 5, Line 25-27) Claim 1 itself recites “transforming the metadata element into a rendered element by using the rendering instruction”. To meet this limitation, according to the Examiner’s own definitions, the annotation (or annotation record) of Lerner would have to be transformed into a rendered element according to the image file of Lerner and the resulting transformed annotation record displayed. Nowhere does Lerner disclose this. In fact, the image file of Lerner itself contains “the appearance of the annotations.” (See Lerner, Col. 5, Lines 25-27) Thus, there is no need in Lerner to transform the annotation record according to the image file. Accordingly, Applicant respectfully submits that asserting Lerner discloses transforming the metadata element into a rendered element using the rendering instruction as recited by Claim 1 requires a tortured reading and interpretation of both the specification of the present application and of the Lerner reference. Consequently, Applicant respectfully submits that Lerner does not disclose transforming the metadata element into a rendered element using the rendering instruction, as recited by Claims 1

Accordingly, as Lerner does not disclose all the limitations of Claim 1, Applicant respectfully submits that Lerner does not anticipate Claim 1, and respectfully requests the withdrawal of the rejection of Claim 1. As Claims 12, 23 and 24 recite limitations similar to

those in Claim 1 Applicant respectfully requests the withdrawal of the rejection of Claims 12, 23 and 24 as well.

Claims 2-4, 8-11, 13-15 and 19-22

As Claims 2-4, 8-11, 13-15 and 19-22 depend directly or indirectly on Claims 1 or 12, Applicant respectfully submits that the above arguments apply equally well with respect to Claims 2-4, 8-11, 13-15 and 19-22 and respectfully requests the withdrawal of the rejection of these claims.

Rejections under 35 U.S.C. § 103

Claims 5-7 and 16-18 stand rejected as obvious over U.S. Patent No. 6,859,909 ("Lerner"). As Claims 5-7 and 16-18 are dependent on Claims 1 or 12, Applicant respectfully submits that the above arguments apply equally well to Claims 5-7 and 16-18. Accordingly, withdrawal of this rejection is respectfully requested.

Newly Added Claim 26-32

Applicant has added Claims 26-32 to more distinctly point out and claim the present invention, support for which can be found in the specification at least in paragraphs [0023]-[0034].

More specifically, newly added Claim 26 recites obtaining a metadata element, wherein obtaining a metadata element comprises accessing a first file comprising a set of metadata elements, each of the metadata elements corresponding to one or more target elements, locating the one or more target elements to which the metadata element corresponds, wherein locating the one or more target elements comprises accessing a second file comprising code operable, when rendered, to present a target document and processing a portion of the code to locate the one or more target elements, locating a rendering instruction corresponding to the metadata element, wherein locating the rendering instruction comprises accessing a third file comprising a set of rendering instructions and rendering the metadata element in conjunction

with the one or more corresponding target elements when rendering the target document, wherein the metadata element is rendered according to the corresponding rendering instruction.

Applicant respectfully submits that after a review of the prior art cited Applicant cannot find where the prior art discloses at least:

- accessing a first file comprising a set of metadata elements, each of the metadata elements corresponding to one or more target elements,
- accessing a second file comprising code operable, when rendered, to present a target document and processing a portion of the code to locate the one or more target elements or
- locating the rendering instruction comprises accessing a third file comprising a set of rendering instructions

Accordingly, Applicant respectfully requests allowance of these claims.

#### CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for allowance. Other than as explicitly set forth above, this reply does not include an acquiescence to statements, assertions, assumptions, conclusions, or any combination thereof in the Office Action. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests full allowance of Claims 1-24 and 26-32. The Examiner is invited to telephone the undersigned at the number listed below for prompt action in the event any issues remain.

The Director of the U.S. Patent and Trademark Office is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 50-3183 of Sprinkle IP Law Group.

Respectfully submitted,

**Sprinkle IP Law Group**  
Attorneys for Applicant

Ari Q. Akmal  
Reg. No. 51,388



Date: July 11, 2006

1301 W. 25<sup>th</sup> Street, Suite 408  
Austin, TX 78705  
Tel. (512) 637-9226  
Fax. (512) 371-9088